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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,103	01/19/2001	Kenichi Kurata	Q62224	4519
7590 02/07/2006 SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Ave., N.W. Washington, DC 20037			EXAMINER LASTRA, DANIEL	
			ART UNIT 3622	PAPER NUMBER
DATE MAILED: 02/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/764,103

Applicant(s)

KURATA ET AL.

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-8,12-14,16,18,19,22,23,30,31,34,35 and 53-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-8,12-14,16,18,19,22,23,30,31,34,35 AND 53-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08/25/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 6-8, 12-14, 16, 18, 19, 22, 23, 30, 31, 34, 35 and 53-79 have been examined. Application 09/764,103 (Image-forming system employing a cartridge and providing a benefit to a user) has a filing date 01/19/2001 and claims foreign priority# 2000-014050 (01/19/2000).

### ***Response to Amendment***

2. In response to Final Rejection filed 06/28/2005, the Applicant filed an Amendment on 11/28/2005, which amended claims 6-8, 12-14, 16, 18, 19, 22, 23, 30, 31, 34, 35, cancel claims 1-5, 9-11, 15, 17, 20, 21, 24-29, 32, 33, 36-52 and added new claims 53-79.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8, 12, 13, 14, 16, 18, 19, 22, 23, 30, 31, 34, 35, 57-68 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meade (US 6,405,214) in view of Helterline et al (U.S. 6,039,430) and further in view of Kelly (US 6,645,068).

As per claims 6-8, 12, 13, 18, 19, 22, 23, 30, 31, 34, 35, 57-68 and 79 Meade teaches:

An image-forming system employing a host apparatus and an image-forming apparatus which are mutually connected, comprising:

a component that determines whether something has been won in connection with use of the image-forming apparatus or the host apparatus, and reads the prize data from the memory element and uses the prize data to award a prize to a user when the results of that determination indicate that something has been won, as a result of which the user is made able to receive the prize upon exchange of the cartridge thereof. Wherein the prize data comprises at least one species selected from among the group consisting of image data serving as prize itself, image-forming apparatus driver information serving as a prize itself, a keyword or password which must be supplied to a prescribed prize awarding organization in order to obtain a prize, and a URL of a network site which awards a prize (see Meade column 5, lines 1-20).

Meade fails to teach:

a replaceable cartridge possessing a memory element being installed in the image forming apparatus. However, Helterline teaches a replaceable cartridge possessing a memory element being installed in the image forming apparatus (see Helterline figure 2A, item 38; column 8, lines 59-65).

Meade fails to teach and lottery determination data for determining whether something has been won being stored in the memory element; a reading component for reading the lottery determination data from the memory element; a lottery determination component that uses lottery determination data read by the reading component to determine whether something has been won; and a prize awarding component that

performs processing for awarding a prize to a user in correspondence to the results of a determination carried out by the lottery determination component when the results of such determination indicate that something has been won and prize data, being a prize itself or data for obtaining a prize from a prescribed prize awarding organization, being stored in the memory element. However, Kelly teaches a system that reads an identification code from the memory of replaceable cartridges and uses said code to allow users to play a game of chance (see Kelly column 4, lines 45-55; column 12, lines 30-55) Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would use the users' printer usage data or the printer's cartridge identification number (see Helterline column 5, lines 34-41) to participate in incentive programs such as games of chance and determine if said users have won prizes, as taught by Kelly. This feature would encourage users to print more pages and would also serve to target promotions to users based upon the users' printing profile.

As per claims 14 and 16, Meade does not expressly teach the image-forming system according to claim 13 further comprising a component for preventing repeated awarding of prizes based on the same usage data in connection with the same cartridge. However, Kelly teaches a system that verifies the accuracy of fulfillment of awards (see Kelly column 15, lines 1-20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would keep track of the printer usage data to determine the credits that would be extended to users and would use the Kelly's verification system to prevent that prizes

are awarded incorrectly. Preventing repeated awarding of prizes would control the Helterline's expenses of running the system.

As per claim 79, Meade teaches:

A method for providing a benefit, comprising the steps of  
writing a user ID for specifying a user to a memory element which has a cartridge ID stored therein, the memory element being possessed by the cartridge attached to the image forming apparatus (see column 5, lines 5-20);

acquiring the user ID and the cartridge ID from the memory element of a recovered cartridge (see column 5, lines 5-20);

Meade fails to teach increasing a point value corresponding to the acquired user ID by using a point value corresponding to the acquired cartridge ID; and providing a user specified by the acquired user ID with a benefit when the increased point value exceeds a predetermined threshold value. However, Kelly teaches a system where sponsors define different incentive programs to allow customers to participate and win prizes, such as points, or credits (see Kelly column 7, lines 50-65). Helterline teaches an apparatus for retrieving information on a replaceable printing component (see column 2, lines 1-20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Helterline would use the users' printer usage data or the printer's cartridge identification number (see Helterline column 5, lines 34-41) to participate in incentive programs such as games or of chance and determine if said users have won prizes, as taught by Kelly. This feature

would encourage users to print more pages and would also serve to target promotions to users based upon the users' printing profile.

4. Claims 69-72 and 75-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meade et al (U.S. 6,405,214) in view of Hayward et al (U.S. 6,629,134).

As per claims 69, 71, 75-78, Meade teaches:

A method for providing information online from an information-providing server in response to a request from a client who has an image-forming apparatus attached replaceably to a cartridge, the method comprising:

transmitting information indicating a printing environment to the information-providing server (see column 5, lines 5-20);

transmitting a software for control, which is used when the client performs printing using the cartridge, to the client on the basis of the information indicating a printing environment which is transmitted from the client (see column 5, lines 5-20); and

Meade fails to teach updating software which requires to be updated to the software for control which has been received from the information-providing server,

wherein the information indicating a printing environment being information related to both resources of the image-forming apparatus and the client. However, Hayward teaches a system that detects computers' peripherals conditions and provides user support based upon said detection (see column 6, lines 20-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would transmit to a remote server computers peripheral

conditions to determine the necessary users support information, as taught by Hayward. In this way the information provided is not only specific to the product configuration of the peripheral as it exists in the product's life cycle, but also specific to the peripheral condition sensed.

As per claim 70, Meade teaches:

The method according to claim 69, but fails to teach wherein the software for control is at least one of a printer driver and a printer firmware that are used when performing printing using the cartridge. However, Hayward teaches a system that detects computers' peripherals conditions and provides user support based upon said detection (see column 6, lines 20-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would transmit to a remote server computers peripheral conditions to determine the necessary users support information, as taught by Hayward. In this way the information provided is not only specific to the product configuration of the peripheral as it exists in the product's life cycle, but also specific to the peripheral condition sensed.

As per claim 72, Meade teaches:

The method according to claim 71, but fails to teach wherein the cartridge is provided with a memory element, an ID of the cartridge is stored in the memory element of the cartridge, and the information-providing server has a web page corresponding to the cartridge ID and for providing sample printing data, the method further comprising:

reading the ID of the cartridge from the memory element of the cartridge, and automatically accessing the web page corresponding to the ID of the cartridge which is



in the memory element of the cartridge and has been read by the image-forming apparatus. However, Hayward teaches a system that detects computers' peripherals conditions and provides user support based upon said detection (see column 6, lines 20-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would transmit to a remote server computers peripheral conditions to determine the necessary users support information, as taught by Hayward. In this way the information provided is not only specific to the product configuration of the peripheral as it exists in the product's life cycle, but also specific to the peripheral condition sensed.

5. Claims 53-56, 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meade (US 6,405,214) in view of Helterline et al (U.S. 6,039,430) and further in view of Hayward et al (U.S. 6,629,134).

As per claims 53 and 55, Meade teaches:

A system which uses a host apparatus and image-forming apparatus that are connected to each other and a server to which the host apparatus is communicably connected, wherein:

a URL for the server and a password for permitting access to the server are stored in the memory element of the cartridge; the image-forming apparatus comprises a first reading component for reading the URL from the memory element of the cartridge, and a second reading component for reading the password from the memory element of the cartridge; and the host apparatus comprises an access component for accessing the server indicated by the URL by using the URL, and a password-

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transmitting component for transmitting the password inside the memory element of the cartridge, which has been read by the second reading component of the image-forming apparatus, to the server in response to an inquiry sent from the server, thereby connecting to the server (see Meade column 2, lines 15-25; column 5, lines 4-20). Meade fails to teach a replaceable cartridge with a memory element is attached to the image-forming apparatus. However, Helterline teaches a replaceable cartridge with a memory element (see Helterline figure 2A, item 38; column 8, lines 59-65);

Hayward teaches a system that detects users' computers peripherals conditions and provides to the users support information based upon said detection (see Hayward column 6, lines 20-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Helterline and Meade would transmit to a remote server users' computer peripheral conditions for the purpose of transmitting to the users support information and target promotions, as taught by Hayward. In this way the information provided is not only specific to the product configuration of the peripheral as it exists in the product's life cycle, but also to the peripheral condition sensed.

As per claims 54 and 56, Meade teaches:

The system according to claim 53, wherein

an ID of the cartridge is also stored in the memory element of the cartridge, the server has a web page corresponding to the cartridge ID and for providing sample printing data, the image-forming apparatus further comprises a third reading component

for reading the cartridge ID from the memory element of the cartridge (see column 5, lines 5-20), and

Meade fails to teach the host apparatus further comprises a printing data access component for automatically accessing the web page corresponding to the ID which is in the memory element of the cartridge and has been read by the third reading component of the image-forming apparatus. However, Hayward teaches a system that detects computers' peripherals conditions and provides user support based upon said detection (see column 6, lines 20-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would transmit to a remote server computers peripheral conditions to determine the necessary users support information, as taught by Hayward. In this way the information provided is not only specific to the product configuration of the peripheral as it exists in the product's life cycle, but also specific to the peripheral condition sensed.

As per claim 73, Meade teaches:

The information-providing method according to claim 69 or 71, but fails to teach wherein the cartridge is provided with a memory element, and a URL for the information-providing server and a password for permitting access to the information-providing server by the client are stored in the memory element, the method further comprising: reading the URL from the memory element of the cartridge, using the URL to access the information-providing server indicated by the URL, reading the password from the memory element of the cartridge, and transmitting the password inside the memory element of the cartridge, which has been read by the image-forming apparatus,

to the server in response to an inquiry sent from the information-providing server, thereby connecting to the server. Meade teaches a system that uses cookies, which contains passwords and users' ID, to allow users to log in to third-party websites to transmit the users' printing profile data (see Meade column 2, lines 15-25; column 5, lines 4-20). Helterline teaches a replaceable cartridge with a memory element (see Helterline figure 2A). Hayward teaches a system that detects users' computers peripherals conditions and provides to the users support information based upon said detection (see Hayward column 6, lines 20-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Helterline and Meade would transmit to a remote server users' computer peripheral conditions for the purpose of transmitting to the users support information and target promotions, as taught by Hayward. In this way the information provided is not only specific to the product configuration of the peripheral as it exists in the product's life cycle, but also to the peripheral condition sensed.

As per claim 74, Meade teaches:

The information-providing method according to claim 73, but fails to teach wherein a range of permitting the access in the information-providing server is set to a range, which is different depending on the password. However, Official Notice is taken that it is old and well known in the computer art that different password allow different range of access to data. Meade teaches a system that uses cookies, which contains passwords and users' ID, to allow users to log in to third-party websites to transmit the users' printing profile data (see Meade column 2, lines 15-25; column 5, lines 4-20).

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Hayward teaches a system that detects users' computers peripherals conditions and provides to the users support information based upon said detection (see Hayward column 6, lines 20-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would transmit to a remote server users' computer peripheral conditions for the purpose of transmitting to the users support information and target promotions, as taught by Hayward. In this way the information provided is not only specific to the product configuration of the peripheral as it exists in the product's life cycle, but also to the peripheral condition sensed.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra  
January 26, 2006

*Yehdega Retta*  
RETTA YEHDEGA  
PRIMARY EXAMINER